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OFFICE OF PETITIONS

In re Application of
Vieri Vanghi
Application No. 09/940,293
Filed: August 27, 2001
Attorney Docket No. 4740-009

:
: **DECISION ON APPLICATION**
: **FOR PATENT TERM ADJUSTMENT**
:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed April 21, 2006. Applicants request that the patent term adjustment at the time of the mailing of the Notice of Allowance be corrected from five hundred ninety-three (593) days to six hundred eighty (680) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is SIX HUNDRED EIGHTY (680) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 8, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 593 days. The instant application for patent term adjustment was timely filed¹. Applicants dispute the reduction of 87 days of PTA for applicant delay in filing an Information Disclosure Statement (IDS) on November 18, 2004. Applicants state that the IDS was filed responsive to a foreign search report mailed by a foreign patent office on November 15, 2004.

On August 27, 2004 applicants filed a response to the non-final Office action mailed June 22, 2004. Then on November 22, 2004, applicants filed the Information Disclosure Statement (IDS). Pursuant to 37 CFR § 1.704(c)(8), the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage in reasonable efforts to conclude prosecution. The record does not support a conclusion that the IDS was expressly requested by the examiner. Accordingly, filing of the IDS may be considered a failure to engage and a proper basis for reduction.

¹ PALM records indicate that the Issue Fee was also received on April 21, 2006.

However, the record supports a conclusion that the IDS was received November 22, 2004 with a 37 CFR 1.704(d) statement.

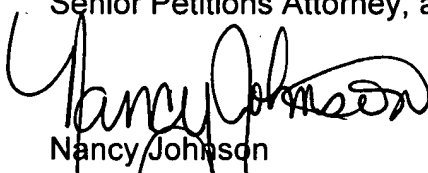
37 CFR 1.704(d) provides that a paper containing only an information disclosure statement in compliance with 37 CFR 1.97 and 1.98 will not be considered (result in a reduction) under 37 CFR 1.704(c)(6), 1.704(c)(8), 1.704(c)(9), or 1.704(c)(10) if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in 37 CFR 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This provision will permit applicants to submit information first cited in a communication from a foreign patent office in a counterpart application to the Office without a reduction in patent term adjustment if an information disclosure statement is promptly (within thirty days of receipt of the first communication) submitted to the Office. Compliance with the statement requirement of 37 CFR 1.704(d) does not substitute for compliance with any relevant requirement of 37 CFR 1.97 or 1.98. 37 CFR 1.704(d) also provides that this thirty-day period is not extendable if it was expressly requested by the examiner, within the meaning of § 1.704(c)(8). Accordingly, no reduction is warranted.

In view thereof, no reduction should have been taken for the filing of the IDS after the mailing of the non-Final Office Action on March 23, 2005.

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The Office will refer the matter to the Office of Patent Publication so that a patent can be issued.

Telephone inquiries specific to this matter should be directed to Patricia Faison-Ball, Senior Petitions Attorney, at (571) 272-3212.


Nancy Johnson
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Office of Petitions